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SHOOK, HARDY & BACON L.L.P.
Intellectual Property Department
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

EXAMINER
SQUIRES, ELIZA A

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/750,478	DOYEL ET AL.
	Examiner	Art Unit	
	Eliza Squires	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 December 2003</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-48</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-48</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>31 December 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

This communication is in response to the application filed on 31 December 2003. Claims 1-48

are pending.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

2.   **Claims 1-34** are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter. The claims are directed generally to a "method in a computer

system", however, it is lacking a substantial tie to another statutory class in the body of the

claim. In order for a method to be considered a "process" under 35 U.S.C. 101, a claimed process

must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform

underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184

(1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70

(1972). If neither of these requirements is met by the claim, the method is not a patent eligible

process under 35 U.S.C. 101 and is nonstatutory subject matter. The claims recite no substantive

tie to another statutory class in the body of the claims.

3.   **Claims 35-43, 45 and 47** are rejected under 35 U.S.C. 101 because the claimed invention

is directed to non-statutory subject matter software per se where the claim recites the term

"means for" these components can be directed to "modules" (modules are described as computer

program instructions paragraph [0029] of the specification) for performing those functions

therefore software per se. Claims to computer-related inventions that are clearly nonstatutory fall

into the same general categories as nonstatutory claims in other arts, namely natural phenomena

such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material."

Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of

abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable.

Descriptive material can be characterized as either "functional descriptive material" or

"nonfunctional descriptive material." In this context, "functional descriptive material" consists of

data structures and computer programs which impart functionality when employed as a computer

component. (The definition of "data structure" is "a physical or logical relationship among data

elements, designed to support specific data manipulation functions." The New IEEE Standard

Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive

material" includes but is not limited to music, literary works and a compilation or mere

arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as

descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional

descriptive material is recorded on some computer-readable medium it becomes structurally and

functionally interrelated to the medium and will be statutory in most cases since use of

technology permits the function of the descriptive material to be realized.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

5.   **Claims 17-21** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

      a.   **Claims 17 and 47** recites "If so, warning of the possible adverse reaction..." this

      statement renders the claim indefinite as there is no course of action specified for the case

      "If not..." and is therefore rejected. **Claims 18-21** are dependant upon the claim and are

      rejected for the same reasons.

      b.   **Claim 19 and 39** recite "the system determines whether the person is allergic to

      the medication". The term "the system" lacks antecedent basis, additionally, it is unclear

      how the method would make this determination. The claim is therefore rejected.

      c.   **Claims 22-34** recite "a computerized system" in the preamble however does not

      disclose system components within the body of the claim. It is unclear the components

      that comprise the system of the claims.

      d.   **Claims 35-43, 45, 47** recites "a computerized system" in the preamble while the

      body of the claim recites software components. It is unclear the components that

      comprise the system recited by the claims.

6.   **Claims 43, 45, and 47** are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

a.   **As to claims 43, 45 and 47** claim elements "means for obtaining", "means for

displaying" and "means for determining" are means (or step) plus function limitations

that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to

disclose the corresponding structure, material, or acts for the claimed functions.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or

step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly

recites what structure, material, or acts perform the claimed function without introducing

any new matter (35 U.S.C. 132(a)). If applicant is of the opinion that the written

description of the specification already implicitly or inherently discloses the

corresponding structure, material, or acts so that one of ordinary skill in the art would

recognize what structure, material, or acts perform the claimed function, applicant is

required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly

recites the corresponding structure, material, or acts for performing the claimed function

and clearly inks or associates the structure, material, or acts to the claimed function,

without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP 2181 and 608.01(o).

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

8.   **Claims 1-7, 23-34 and 43** are rejected under 35 U.S.C. 102(e) as being anticipated by

U.S. Patent 7,464,041 to *Merkin et al*.

9.   **As to claim 1,** *Merkin* discloses a method in a computer system for automatically

determining whether an expectation for a health maintenance item has been satisfied, the method

comprising:

         generating an expectation for a health maintenance item for a person (*Merkin* column 9

lines 43-61 wherein an expectation is cervical cancer screening for women ages 18-64); and

         automatically determining whether the expectation has been satisfied (*Merkin* column 9

lines 43-67 and column 10 lines 1-17).

10.   **As to claim 2,** see the discussion of claim 1, additionally, *Merkin* discloses the method

wherein the expectation is satisfied by searching an integrated database in a comprehensive

healthcare system to determine if an existing order has been placed for the expectation (*Merkin*

column 4 lines 30-47, column 9 lines 43-67, and column 10 lines 1-17). Examiner notes that an

order could be an appointment being made alternatively a fulfilled order would be an addition to

a patient record documenting the completed procedure.

11.   **As to claim 3,** see the discussion of claim 1, additionally, *Merkin* discloses the method wherein the expectation is satisfied by searching an integrated database in a comprehensive healthcare system to determine if a procedure has been documented (*Merkin* column 6 lines 11-51, column 9 lines 43-67, and column 10 lines 1-17).

12.   **As to claim 4,** see the discussion of claim 1, additionally, *Merkin* discloses the method wherein the expectation is satisfied by searching an integrated database in a comprehensive healthcare system to determine if one or more result values exist for the expectation (*Merkin* column 6 lines 11-51, column 9 lines 43-67, and column 10 lines 1-17).

13.   **As to claim 5,** see the discussion of claim 1, additionally, *Merkin* discloses the method wherein the expectation is satisfied by receiving an order for a satisfier for the expectation (*Merkin* column 4 lines 30-47, column 6 lines 11-51, column 9 lines 43-67, and column 10 lines 1-17, column 11 lines 38-53, and figures 1 and 2).

14.   **As to claim 6,** see the discussion of claim 1, additionally, *Merkin* discloses the method wherein the expectation is satisfied by receiving documentation of a result that is a satisfier for the expectation (*Merkin* column 9 lines 43-67 and column 10 lines 1-17).

15.   **As to claim 7,** see the discussion of claim 1, additionally, *Merkin* discloses the method wherein the health maintenance item is one of a screening (*Merkin* column 9 lines 43-67 and column 10 lines 1-17).

16.   **As to claim 23,** *Merkin* discloses a computerized system for automatically determining whether an expectation for a health maintenance item has been satisfied, the system comprising:

a generating module for generating an expectation for a health maintenance item for a person (*Merkin* column 9 lines 43-61 wherein an expectation is cervical cancer screening for women ages 18-64); and

a determining module for automatically determining whether the expectation has been satisfied (*Merkin* column 9 lines 43-67 and column 10 lines 1-17).

17.   **As to claim 24,** see the discussion of claim 23, additionally, *Merkin* discloses the system wherein the expectation is satisfied by searching an integrated database in a comprehensive healthcare system to determine if an existing order has been placed for the expectation (*Merkin* column 4 lines 30-47, column 9 lines 43-67, and column 10 lines 1-17).

18.   **As to claim 25,** see the discussion of claim 23, additionally, *Merkin* discloses the system wherein the expectation is satisfied by searching an integrated database in a comprehensive healthcare system to determine if a procedure has been documented (*Merkin* column 6 lines 11-51, column 9 lines 43-67, and column 10 lines 1-17).

19.   **As to claim 26,** see the discussion of claim 23, additionally, *Merkin* discloses the system wherein the expectation is satisfied by searching an integrated database in a comprehensive healthcare system to determine if one or more result values exist for the expectation (*Merkin* column 6 lines 11-51, column 9 lines 43-67, and column 10 lines 1-17).

20.   **As to claim 27,** see the discussion of claim 23, additionally, *Merkin* discloses the system wherein the expectation is satisfied by receiving an order for a satisfier for the expectation (*Merkin* column 4 lines 30-47, column 6 lines 11-51, column 9 lines 43-67, and column 10 lines 1-17, column 11 lines 38-53, and figures 1 and 2).

21.   **As to claim 28,** see the discussion of claim 23, additionally, *Merkin* discloses the system wherein the expectation is satisfied by receiving documentation of a result that is a satisfier for the expectation (*Merkin* column 6 lines 11-51, column 9 lines 43-67, and column 10 lines 1-17).

22.   **As to claim 29,** see the discussion of claim 23, additionally, *Merkin* discloses the system wherein the health maintenance item is one of a screening (*Merkin* column 9 lines 43-67 and column 10 lines 1-17).

23.   **As to claim 30,** see the discussion of claim 23, additionally, *Merkin* discloses the system further comprising an obtaining module for obtaining information for the person from the person's electronic medical record in a comprehensive healthcare system (*Merkin* column 9 lines 43-67 and column 10 lines 1-17).

24.   **As to claim 31,** see the discussion of claims 23 and 30, additionally, *Merkin* discloses the system further comprising a second obtaining module for obtaining one or more recommended health maintenance items (*Merkin* column 9 lines 43-67 and column 10 lines 1-17 also see claim 1).

25.   **As to claim 32,** see the discussion of claims 23 and 30-31, additionally, *Merkin* discloses the system further comprising a third obtaining module for obtaining the factors that would qualify a person for the one or more health maintenance items (*Merkin* column 4 lines 16-29).

26.   **As to claim 33,** see the discussion 23 and 30-32, additionally, *Merkin* discloses the system further comprising a comparing module for comparing the information for the person with the qualification factors to determine whether the person qualifies for one or more of the one or more recommended health maintenance items (*Merkin* column 11 lines 5-37).

27.   **As to claim 34,** see the discussion of claims 22 and 30-33, additionally, *Merkin* discloses

the system further comprising a storing module for storing the satisfied and unsatisfied

expectations in the person's electronic medical record in a comprehensive healthcare system

(*Merkin* claim 1 step (f) and claim 6).

28.   **As to claim 43,** *Merkin* discloses a system in a computerized environment for

automatically determining whether an expectation for a health maintenance item has been

satisfied, the method comprising:

        means for generating an expectation for a health maintenance item for a person (*Merkin*

column 9 lines 43-61 wherein an expectation is cervical cancer screening for women ages 18-

64); and

        means for automatically determining whether the expectation has been satisfied (*Merkin*

column 9 lines 43-67 and column 10 lines 1-17).

29.   **Claims 17-20, 37-40, and 47** are rejected under 35 U.S.C. 102(e) as being anticipated by

U.S. Patent Application 2003/0154107 to *Medvedeff.*

30.   **As to claim 17,** *Medvedeff* discloses a method in a computer system for determining

whether a patient may experience an adverse reaction to a satisfier chosen for an expectation for

a health maintenance item, them method comprising:

>   receiving a satisfier for an expectation for a health maintenance item (*Medvedeff*
>
>   paragraph [0033]);
>
>   obtaining healthcare information for a person (*Medvedeff* paragraph [0031]);
>
>   determining whether the person may have an adverse reaction to the satisfier (*Medvedeff*

paragraph [0034]); and

>   if so, warning of the possible adverse reaction to the satisfier (*Medvedeff* figures 4C and

4D).

31.   **As to claim 18,** see the discussion of claim 17, additionally *Medvedeff* discloses the

method wherein the satisfier is an order for a medication (*Medvedff* figure 4B and paragraphs

[0033] – [0035]).

32.   **As to claim 19,** see the discussion of claims 17 and 18, additionally, *Medvedeff* discloses

the method wherein a determination is made as to whether the person is allergic to the

medication (*Medvedeff* figures 3 and 4).

33.   **As to claim 20,** see the discussion of claim 17, additionally, *Medvedeff* discloses the

method wherein the healthcare information for a person is obtained for the patient's electronic

medical record in a comprehensive healthcare environment (*Medvedeff* figures 3 and 4).

Examiner notes the use of intended use type language "for the patient's electronic medical

record". See MPEP § 2106 and 2111.04.

34.   **As to claim 37,** *Medvedeff* discloses a computerized system for determining whether a

patient may experience an adverse reaction to a satisfier chosen for an expectation for a health

maintenance item, them method comprising:

        a receiving module for receiving a satisfier for an expectation for a health maintenance

item (*Medvedeff* paragraph [0033]);

        an obtaining module for obtaining healthcare information for a person (*Medvedeff*

paragraph [0031]);

        a determining module for determining whether the person may have an adverse reaction

to the satisfier (*Medvedeff* paragraph [0034]); and

        a warning module for warning of the possible adverse reaction to the satisfier (*Medvedeff*

figures 4C and 4D).

35.   **As to claim 38,** see the discussion of claim 37, additionally, *Medvedeff* discloses the

system wherein the satisfier is an order for a medication (*Medvedeff* figure 4B and paragraphs

[0033] – [0035]).

36.   **As to claim 39,** see the discussion of claim 37 and 38, additionally, *Medvedeff* discloses

the system wherein a determination is made as to whether the person is allergic to the medication

(*Medvedeff* figures 3 and 4).

37.   **As to claim 40,** see the discussion of claim 37, additionally, *Medvedeff* discloses the

system wherein the healthcare information for a person is obtained for the patient's electronic

medical record in a comprehensive healthcare environment (*Medvedeff* figures 3 and 4).

Examiner notes the use of intended use type language "for the patient's electronic medical
record". See MPEP § 2106 and 2111.04.

38.   **As to claim 47,** *Medvedeff* discloses a system in a computerized environment for
determining whether a patient may experience an adverse reaction to a satisfier chosen for an
expectation for a health maintenance item, them method comprising:

    means for receiving a satisfier for an expectation for a health maintenance item
(*Medvedeff* paragraph [0033]);

    means for obtaining healthcare information for a person (*Medvedeff* paragraph [0031]);

    means for determining whether the person may have an adverse reaction to the satisfier
(*Medvedeff* paragraph [0034]); and

    if so, warning of the possible adverse reaction to the satisfier (*Medvedeff* figures 4C and
4D).

Claim Rejections - 35 USC § 103

39.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

40.   **Claims 8-16, 35-36, and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable

over *Merkin* in view of U.S. Patent Application 2004/0243619 to *Kelly et al.*

41.   **As to claim 8,** *Merkin* discloses the method substantially as claimed in claim 1; however

Merkin does not explicitly teach receiving a request for health maintenance items for a patient. In

a similar field of endeavor, *Kelly* discloses:

        receiving a request for health maintenance items for a patient (paragraphs [0063]-[0066]

and [0057]).

        It would have been obvious to one of ordinary skill in the art at the time of the invention

to modify *Merkin* with *Kelly* since the combination would improve the users knowledge of the

each of the maintenance items required so that more informed decisions can be made.

42.   **As to claim 9,** see the discussion of claims 1 and 8, additionally, *Kelly* discloses the

method wherein the request is from a user (paragraphs [0063]-[0066] and [0057]).

43.   **As to claim 10,** see the discussion of claims 1 and 8-9, additionally, *Merkin* discloses the

method further comprising obtaining information for the person from the person's electronic

medical record in a comprehensive healthcare system (*Merkin* column 6 lines 11-51, column 9

lines 43-67, and column 10 lines 1-17).

44.   **As to claim 11,** see the discussion of claims 1 and 8-10, additionally, *Merkin* discloses

obtaining one or more recommended health maintenance items (*Merkin* column 4 lines 1-29).

45.   **As to claim 12,** see the discussion of claims 1 and 8-11, additionally, *Merkin* discloses

obtaining the factors that would qualify a person for the one or more health maintenance items

(*Merkin* column 4 lines 16-29).

46.   **As to claim 13,** see the discussion of claims 1 and 8-12, additionally, *Merkin* discloses

the method further comprising comparing the information for the person with the qualification

factors to determine whether the person qualifies for one or more of the one or more

recommended health maintenance items (*Merkin* column 11 lines 5-37).

47.   **As to claim 14,** see the discussion of claims 1 and 8-13, additionally, *Merkin* discloses

the method further comprising generating an expectation for each of the health maintenance

items for which the patient qualifies (*Merkin* claim 1 part (d), column 9 lines 43-67, and column

10 lines 1-17).

48.   **As to claim 15,** *Merkin* discloses a method in a computer system for generating satisfiers

for an expectation for a health maintenance item, the method comprising:

       obtaining one or more unsatisfied health maintenance item expectations for a person

(*Merkin* claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17);

       obtaining possible satisfiers for each of the one or more unsatisfied expectations (*Merkin*

claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17); and

       determining the possible satisfiers for each of the one or more unsatisfied expectations

(*Merkin* claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17).

However, *Merkin* does not explicitly teach displaying the possible satisfiers. *Kelly* makes this disclosure (*Kelly* paragraph [0031]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included in the method of *Merkin* the use of a display of *Kelly* since the combination improves the ease of use of the system.

49.   **As to claim 16,** see the discussion of claim 15, additionally, *Kelly* discloses the method wherein possible satisfiers are obtained from a pre-defined list for each health maintenance item stored in a database (*Kelly* paragraphs [0057], [0023], [0022]).

50.   **As to claim 35,** *Merkin* discloses a computerized system for generating satisfiers for an expectation for a health maintenance item, the system comprising:

an obtaining module for obtaining one or more unsatisfied health maintenance item expectations for a person (*Merkin* claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17);

a second obtaining module for obtaining possible satisfiers for each of the one or more unsatisfied expectations (*Merkin* claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17); and

an obtaining module for obtaining the possible satisfiers for each of the one or more unsatisfied expectations (*Merkin* claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17).

However, *Merkin* does not explicitly teach displaying the possible satisfiers. *Kelly* makes this disclosure (*Kelly* paragraph [0031]).

It would have been obvious to one of ordinary skill in the art at the time of the invention
to have included in the method of *Merkin* the use of a display of *Kelly* since the combination
improves the ease of use of the system.

51.   **As to claim 36,** see the discussion of claim 35, additionally, *Kelly* discloses the system
wherein possible satisfiers are obtained from a pre-defined list for each health maintenance item
stored in a database (*Kelly* paragraphs [0057], [0023], [0022]).

52.   **As to claim 45,** *Merkin* discloses a system in a computerized environment for generating
satisfiers for an expectation for a health maintenance item, the method comprising:

means for obtaining one or more unsatisfied health maintenance item expectations for a
person (*Merkin* claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17);

means for obtaining possible satisfiers for each of the one or more unsatisfied
expectations (*Merkin* claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17); and

means for obtaining the possible satisfiers for each of the one or more unsatisfied
expectations (*Merkin* claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17).

However, *Merkin* does not explicitly teach displaying the possible satisfiers. *Kelly* makes
this disclosure (*Kelly* paragraph [0031]).

It would have been obvious to one of ordinary skill in the art at the time of the invention
to have included in the method of *Merkin* the use of a display of *Kelly* since the combination
improves the ease of use of the system.

53.   **Claims 21, 22, 41, and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Medcedeff* in view of U.S. Patent 5,758,095 to *Albaum et al.*

54.   **As to claim 21,** *Medvedeff* discloses the method substantially as claimed in claim 17 above; however, *Medvedeff* does not explicitly teach a database containing possible adverse reactions. *Albaum* discloses the method further comprising obtaining information regarding possible adverse reactions to the satisfier from a database (*Albaum* column 3 lines 21-47).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of *Medvedeff* with the database of *Albaum* since the combination would improve efficiency by creating a single source for adverse reaction information.

55.   **As to claim 22,** see the discussion of claims 17 and 21, additionally, *Albaum* discloses the method further comprising comparing the information regarding possible adverse reactions to healthcare information for the person to determine whether the person may have an adverse reaction to the satisfier (*Albaum* column 3 lines 21-47).

56.   **As to claim 41,** *Medvedeff* discloses the system substantially as cliamed in claim 37 and 40; however the reference does not explicitly teach a database containing possible adverse reactions. *Albaum* discloses a second obtaining module for obtaining information regarding possible adverse reactions to the satisfier from a database (*Albaum* column 3 lines 21-47).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of *Medvedeff* with the database of *Albaum* since the combination would improve efficiency by creating a single source for adverse reaction information.

57.   **As to claim 42,** see the disdcussion of claims 37 and 40-41, additionally, *Albaum* discloses the system further comprising a comparing module for comparing the information

regarding possible adverse reactions to healthcare information for the person to determine

whether the person may have an adverse reaction to the satisfier (*Albaum* column 3 lines 21-47).

58.   **Claim 44** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Merkin* in view

of U.S. Patent No. 6,272,472 to *Danneels et al.*

59.   **As to claim 44,** *Merkin* discloses the method comprising;

generating an expectation for a health maintenance item for a person (*Merkin* column 9

lines 43-61 wherein an expectation is cervical cancer screening for women ages 18-64); and

automatically determining whether the expectation has been satisfied (*Merkin* column 9

lines 43-67 and column 10 lines 1-17).

However, *Merkin* does not teach that the method is embodied on a computer readable

medium. *Danneels,* teaches a computer-implemented method realized as one or more programs

on a computer (see column 2, lines 40-46 *of Danneels*). In addition, *Danneels* teaches that the

programs are storable on a computer-readable medium such as a floppy disk or a CD-ROM (see

column 2, lines 46-49 of *Danneels*).

It would have been prima facie obvious to one of ordinary skill in the art at the time of

the invention to incorporate this feature into the method of *Merkin*. One of ordinary skill in the

art would have been motivated to incorporate this feature for the purpose of distribution and

installation and execution of the software on another computer (see column 7, lines 46-49 of

Danneels et al.).

60.   **Claim 46** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Merkin* in view

of *Kelly* in further view of *Danneels*.

61.   **As to claim 46,** *Merkin* discloses the method comprising;

obtaining one or more unsatisfied health maintenance item expectations for a person

(*Merkin* claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17);

obtaining possible satisfiers for each of the one or more unsatisfied expectations (*Merkin*

claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17); and

determining the possible satisfiers for each of the one or more unsatisfied expectations

(*Merkin* claim 1 part (d), column 9 lines 43-67, and column 10 lines 1-17).

However, *Merkin* does not explicitly teach displaying the possible satisfiers. *Kelly* makes

this disclosure (*Kelly* paragraph [0031]).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to have included in the method of *Merkin* the use of a display of *Kelly* since the combination

improves the ease of use of the system.

However, *Merkin* and *Kelly* do not teach that the method is embodied on a computer

readable medium. *Danneels,* teaches a computer-implemented method realized as one or more

programs on a computer (see column 2, lines 40-46 *of Danneels*). In addition, *Danneels* teaches

that the programs are storable on a computer-readable medium such as a floppy disk or a CD-

ROM (see column 2, lines 46-49 of *Danneels).*

It would have been prima facie obvious to one of ordinary skill in the art at the time of

the invention to incorporate this feature into the method of *Merkin* and *Kelly*. One of ordinary

skill in the art would have been motivated to incorporate this feature for the purpose of

distribution and installation and execution of the software on another computer (see column 7,

lines 46-49 of *Danneels* et al.).

62.   **Claim 48** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Medvedeff* in

view of *Danneels*.

    As to claim 48, *Medvedeff* discloses the method comprising;

    receiving a satisfier for an expectation for a health maintenance item (*Medvedeff*

    paragraph [0033]);

    obtaining healthcare information for a person (*Medvedeff* paragraph [0031]);

    determining whether the person may have an adverse reaction to the satisfier (*Medvedeff*

paragraph [0034]); and

    if so, warning of the possible adverse reaction to the satisfier (*Medvedeff* figures 4C and

4D).

    However, *Medvedeff* does not teach that the method is embodied on a computer readable

medium. *Danneels,* teaches a computer-implemented method realized as one or more programs

on a computer (see column 2, lines 40-46 *of Danneels).* In addition, *Danneels* teaches that the

programs are storable on a computer-readable medium such as a floppy disk or a CD-ROM (see

column 2, lines 46-49 *of Danneels).*

    It would have been prima facie obvious to one of ordinary skill in the art at the time of

the invention to incorporate this feature into the method of *Medvedeff.* One of ordinary skill in

the art would have been motivated to incorporate this feature for the purpose of distribution and

installation and execution of the software on another computer (see column 7, lines 46-49 of

Danneels et al.).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eliza Squires whose telephone number is (571)270-7052. The examiner can normally be reached on Monday through Friday 8 am - 4 pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. S./
Examiner, Art Unit 3626
12/18/08

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626